

**REMARKS**

Claims 21-24 have been added based on, e.g., the disclosure at page 18, lines 4-9 and 16-23 in the application.

Entry of the above amendment is respectfully requested.

**Obviousness Rejection**

On page 3 of the Office Action, claims 9 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnstone (US 6,262,105 B1) in view of Skuballa et al. (US 4,088,775).

In response, Applicants submit initially that the Declaration evidence previously submitted in regard to the effect on intraocular pressure (IOP) is highly relevant, contrary to the Examiner's apparent indication near the bottom of page 5 of the Office Action that intraocular pressure is not an appropriate basis of comparison.

In this regard, Applicants note that as shown in the experimental data, the elected compound of the present application does not affect on IOP. In contrast, latanoprost, which is used in the Examples in Johnstone, is a potent IOP lowering agent (see, e.g., col. 4, lines 27-32 in Johnstone). As clearly defined on page 18 of the instant specification, "hair" in this application is not limited to those on the head and can refer to eyelashes. When applied on eyelashes, the IOP lowering effect is clearly an unwanted side effect that should be avoided. Therefore, no IOP lowering effect is unexpectedly superior result of the elected compound when used in the claimed method.

Further, Applicants submit herewith another Rule 132 Declaration to demonstrate the unexpected superiority of the present invention. In this Declaration, the hair growth promoting effects of the elected compound and isopropyl unoprostone (Rescula®) are compared. In this regard, Applicants note that isopropyl unoprostone is a compound within the disclosure of Johnstone (see column 10, lines 4-51) and is closer in structure to the present invention than is latanoprost, so Applicants submit that the comparison is an appropriate one. As can be seen from the present Declaration, the elected compound (Compound A), which increased hair growth substantially, provides unexpectedly superior hair growth as compared to isopropyl unoprostone (Compound B), which increased hair growth to a much lesser extent.

A summary of the previously filed Rule 132 Declaration and the present Rule 132 Declaration, as well as the disclosure of Johnstone, with respect to the effects of the compounds is set forth below.

	Decreasing IOP	Increasing Hair Growth
Latanoprost	O	O
Isopropyl Unoprostone	O	O
Elected Compound	X	O

As can be seen from the above, the elected compound provides unexpectedly superior results in that it increases hair growth *without the side effect of decreasing intraocular pressure*.

Further, Applicants submit that the structure of latanoprost is very different from that of the elected species, and thus one of ordinary skill in the art would not have been motivated to choose the elected compound based on latanoprost, the only compound used in the working examples in Johnstone. In addition to latanoprost, isopropyl unoprostone (Rescula®) is also a

well known IOP lowering compound and is covered by the disclosure of the Johnstone specification. Applicants submit that if a person wants to explore a PG analogue that has a hair growth promoting effect based on Johnstone, he or she would explore compounds among those having IOP lowering effect, e.g., in view of the disclosure beginning at col. 6, line 35 regarding how the invention of Johnstone was discovered. Since the compound of the present application has no IOP lowering effect, the artisan would not be motivated to choose the elected compound for examining the hair growth promoting effect.

Thus, Applicants submit that the present invention is not obvious over the cited art combination, and withdrawal of this rejection is respectfully requested.

## **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.114(c)  
U.S. Application No.: 10/567,462

Attorney Docket No.: Q76937

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

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